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Docket No. 08477.0099USC1

**REMARKS**

The application has been carefully reviewed in light of the Office Action dated September 22, 2006. Claims 41-59, 61-74, and 76 remain pending in this case, with Claims 41 and 61 being currently amended. Claims 60 and 75 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the original claims in this application and in other applications.

***Claim Rejections – 35 USC §112, first paragraph***

Claims 41 and 61 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states:

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 41 and 61 recite “wherein the agent is not an employee of the customer”. Nowhere, in Applicant’s specification this limitation is recited.

Claims 41 and 61 have been amended and Applicant respectfully submits that the amendments overcome the rejection. Accordingly, Applicant respectfully request the rejection be withdrawn.

***Claim Rejections – 35 USC §112, second paragraph***

Claims 41 and 61 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action states:

Claims 41 and 61 recite “wherein the agent is not an employee of the customer”. The definition of an employee is “a person working for another person or a business firm for pay” (see dictionary.com). If an agent is conducting an on-line purchase for a customer, said customer is a client of said agent, and therefore, said agent is working for said customer for a pay. Said pay to said agent is based upon the interaction between said agent and said customer. Therefore, said limitation is indefinite because Applicant’s specification does not define the term “wherein the agent is not an employee of the customer”.

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Claims 41 and 61 have been amended and Applicant respectfully submits that the amendments overcome the rejection. Accordingly, Applicant respectfully request the rejection be withdrawn.

***Claim Rejection – 35 USC §103***

Claims 41-59, 61-74, and 76 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,309,355 to Lockwood (hereinafter "Lockwood") in view of U.S. Patent No. 5,239,460 to LaRoche (hereinafter "LaRoche").

Regarding claim 41, Examiner states:

As per claims 41, Lockwood teaches:

A computerized on-line incentive system for awarding points to an agent conducting an on-line purchase for a customer, *wherein the agent is not an employee of the customer* the system comprising:

(a) an access device connected to a network (see column col 1, lines 35-45);

(b) a computerized on-line sales environment, connected to the network and thereby accessible to the agent of the access device, the on-line sales environment permitting the agent to determine items that is for sale and conduct an on-line purchase of said items (see col 1, lines 35-45; col 8, lines 3-18);

Lockwood fails to teach:

(c) an on-line award system connected to the network, the on-line award system being in communication with the on-line sales environment and possessing an account holding a point total corresponding to the agent. However, LaRoche teaches a system that rewards sales agents with award points based upon said agents performance, such as the number or dollar value of sales made by said agents (see LaRoche col 3, lines 20-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application has made, to know that travel agents using the Lockwood's travel reservation system would be motivated to participate in the LaRoche's award system in order to motivate said agents to generate additional sales as said agents would be compensated with award points based upon the number or dollar value of sales made.

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Regarding claim 61, Examiner states:

As per claim 61, Lockwood teaches:

A computerized on-line method for awarding points to an agent conducting an on-line purchase for a customer, wherein the agent is not an employee of the customer, comprising the steps of:

a) receiving on-line purchase information from the agent via an access device connected to a network (see Lockwood column 1, lines 35-45; col 8, lines 5-10);

b) determining availability of an item to be line 62 - col 8, line 10);

Lockwood fails to teach:

c) communicating the on-line purchase following the purchase of said item.

d) awarding points to the agent based on the on-line purchase information; and

e) cumulating the points in a specified account for the agent.

However, LaRoche teaches a system that rewards sales agents with award points based upon said agent performance, such as the number of dollar value of sales made (see LaRoche col 3, lines 20-45). LaRoche keep track of agents awarded points in a specified account for the agents and display said points to the agents in real-time (see LaRoche col 4, lines 6-25). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that travel agents using the Lockwood's travel reservation system would be motivated to participate in the LaRoche's award system in order to motivate said agents to generate additional sales as said agents would be compensated with award points based upon the number or dollar value of sales made.

Applicants have amended Claims 41 and 61 to include the limitations of Claims 60 and 75. Accordingly, Applicants respectfully submit that the rejection of Claims 41 and 61 is moot in view of the remarks concerning Claims 60 and 75, *infra*.

### ***Claim Rejection – 35 USC §103***

Claims 60 and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lockwood in view of LaRoche and further in view of U.S. Patent No. 5,855,369 to Lieberman (hereinafter "Lieberman"). Regarding claims 60 and 75, the Examiner states that Lockwood fails to teach:

[t]he computerized on-line incentive system of claim 41, wherein the on-line awards system modifies the agent's point total in response to adjustment or

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cancellation of the online purchase. However, Lieberman teaches "purchase-required-for-entry" incentive programs where businesses that participates in said programs only give prizes or awards to customers that purchase and attend said participating businesses events. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Lockwood and LaRoche would only give awards to travel agents that place reservations to customers that have attended said reservations or events, as taught by Lieberman in order that Lockwood and LaRoche don't finish giving awards to agents for reservations that were later canceled by said customers, therefore, eliminating the purpose of giving said awards, which is to increase sales.

Applicant respectfully traverses the Action's rejection.

Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements:

- (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings;
- (ii) a reasonable expectation of success; and
- (iii) the prior art references must teach or suggest all claim limitations.

See MPEP §2143; In re Dembiczak, 175 F.3d 994 (Fed. Cir 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996). All three prongs must be met to make a *prima facie* case of obviousness. See MPEP §2142.

Applicants respectfully submit the references cited in the Action's rejection of claims 60 and 75 fail the first prong of obviousness in that there is no suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings. Foremost, Lieberman is non-analogous art. There are two criteria in determining whether a reference is analogous:

- (1) whether the reference is in the field of the applicant's endeavor, regardless of the problem to be addressed, and

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(2) if not in the field of applicant's endeavor, then whether the reference still is reasonably pertinent to the particular problem with which the inventor was concerned.

See In re Clay, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. See In re Clay, 23 USPQ2d at 1061. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem that the invention attempts to solve. Id.

Applicant's invention is not in the same field of endeavor as Lieberman. The present invention, as recited by the claims, relates to a computerized incentive system for awarding credits to persons who book travel-related reservations. See specification, Field of the Invention. In contrast, Lieberman is directed to "prize drawing games of chance, equipment therefore, and method of entering, playing and administering such games." See Lieberman, col. 1, lines 11-13. To the extent that the present invention, as recited by the claims and Lieberman each concern their respective fields of invention, Applicants submit that an inventor in the field of travel-related reservation systems would not reasonably be motivated or expected to look to the field of games of chance. See In re Oetiker, 24 USPQ2d 1443, 1146 (Fed. Cir. 1992) ("It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp [travel reservations], would reasonably be expected or motivated to look to fasteners for garments [games of chance].").

Lieberman is not reasonably pertinent to the particular problem with which the Applicants were concerned. The purpose of Lieberman is to provide methods of entering, playing and administering games of chance. See Lieberman, col. 1, lines 11-13. More specifically, Lieberman relates to "methods and equipment specifically adapted to those prize drawing games of chance aimed at promoting a particular product or item of merchandise ...",

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see Lieberman column 1 lines 15-17. Lieberman discloses the use of bar codes and UPCs as aids in the operation and administration of a product-promotional prize drawing game of chance. The Examiner references Lieberman for the proposition that:

[i]t would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Lockwood and LaRoche would only give awards to travel agents that place reservations to customers that have attended said reservations or events, as taught by Lieberman in order that Lockwood and LaRoche don't finish giving awards to agents for reservations that were later canceled by said customers, therefore, eliminating the purpose of giving said awards, which is to increase sales. See Action page 14.

Applicant respectfully submits that Lieberman does not teach businesses that participate in travel-related reservation systems would only give credit to customers that attend said reservations or events. Applicant has identified in the background of Lieberman a discussion of "[p]urchase required for entry" games, such as prize drawings. Lieberman states, "prize drawings typically require the entrant to purchase, directly or indirectly, a chance to win the offered prize. For example, theaters use patrons' numbered ticket stubs as entry forms in prize drawings; but the theater patron is required, at least indirectly and incidentally, to pay money for a chance to win the drawing, since the patron has an opportunity to participate in such a drawing only because he has purchased a theater ticket bearing a numbered stub." See Lieberman col. 1, lines 16-24. Lieberman further states that:

[p]urchase-required-for-entry" games of chance can be difficult to administer because they are legally problematical in some jurisdictions, where anti-lottery laws prohibit or heavily regulate prize drawing games of chance in which something must be purchased, or in which something of value must otherwise be given by the entrant, in order to have a chance at winning the prize. Hence, the administration of a "purchase-required-for-entry" game of chance may be cumbersome, expensive or even impractical altogether, especially on an interstate scale, due to difficulties in compliance with local variations in the law. Typically, however, legal objections to a prize drawing game of chance may be overcome by providing means to enter the drawing which do not require the entrant, directly or indirectly, to make a purchase or otherwise part with anything of value in return for a chance at winning the prize. Id. at col. 1, line 64 – col. 2 line 12.

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Accordingly, while Lieberman identifies purchase required for entry games, such as prize drawings, these games were identified to set up the discussion of methods of entering prize drawings that "do not require the entrant, directly or indirectly, to make a purchase." The invention disclosed in Lieberman does not require the entrant to make a purchase. Accordingly, Applicant submits that while Lieberman does discuss purchase required for entry games, such as prize drawings in its background, the invention disclosed in Lieberman teaches away from the proposition that an entrant is required to make a purchase. Moreover, the purchase required for entry games, such as prize drawings, discussed in the background of Lieberman, when combined with Lockwood and LaRoche do not result in the system claimed. Applicant respectfully disagrees that combining Lockwood and LaRoche with the statements concerning "purchase required for entry prize drawings" disclosed in the background of Lieberman result in the present invention.

The claimed invention relates to a computerized on-line method for awarding points to an agent conducting an on-line purchase for a customer. Lieberman does not disclose anything relating to agent on-line purchases. Accordingly, Applicant respectfully submits that Lieberman is non analogous art. Applicant directs the Examiner to the Patent Trademark Office (PTO) classification, in further support of the proposition that Lieberman is non-analogous art. See In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Lieberman has a PTO classification of 273 (Amusement devices: games)<sup>1</sup> and the present invention classification is expected to be 705 (Data processing: financial, business practice, management, or cost/price determination)<sup>2</sup> Accordingly, because Lieberman is not analogous art, the Action may not rely upon Lieberman as a reference.

While Applicants are not admitting or suggesting that Lockwood, LaRoche and Lieberman teach all aspects of the claimed invention or even that the references are combinable, *hypothetically assuming* such, there is no motivation to combine the references. As the MPEP

<sup>1</sup> <http://www.uspto.gov/go/classification/selectnumwithtitle.htm>

<sup>2</sup> Expectation is based upon Parent Application SN: 08/892,563 now Patent No. 6,631,355 have a PTO classification of 705.

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states, absent language in the references of the desirability of the combination, the mere fact that the references can be combined does not render the resultant combination obvious. See MPEP §2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.). (Emphasis Added). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

A statement of "it would have been obvious to a person of ordinary skill in the art at the time the application was made ..." is insufficient to overcome the lack of suggestion and/or motivation in the references to combine said references. Specifically the Action states:

It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Lockwood and LaRoche would only give awards to travel agents that place reservations to customers that have attended said reservations or events, as taught by Lieberman in order that Lockwood and LaRoche don't finish giving awards to agents for reservations that were later canceled by said customers, therefore, eliminating the purpose of giving said awards, which is to increase sales.

Applicants respectfully submit that the Action is relying on contentions not supported by the cited references and thereby hindsight reasoning which is impermissible. Simply stating that it would be obvious to combine three references to perform functions of Applicant's invention without citing desirably found within the reference is improper. Applicants respectfully submit that in view of the arguments that Lieberman is non-analogous art, *infra*, only hindsight reasoning would lead to the inclusion of Lieberman because a person would have to search a non-analogous art area to find Lieberman. The Examiner fails to indicate where a suggestion or motivation to combine the references can be found within the cited references as indicated by column or page number(s). See MPEP § 706.02(j).



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If the Action continues to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); MPEP § 2144.03 (providing that the Examiner may only rely on facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.)

Claims 42-59 depend directly or indirectly from claim 41, and claims 62-74 and 76 depend directly or indirectly from claim 61, and are allowable along with claims 41 and 61, respectively, for the reasons mentioned above and on their own merit.

Regarding the Examiner's additional assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above comments and the amendment to the claims. Applicant respectfully submits that claims 41-59, 61-74, and 76 are in condition for allowance.

#### CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Action, and therefore do not address patentable aspects of the invention that were not addressed by the Action. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Action contains a number of statements reflecting characterization of the related art and the claims. Regardless of whether any such statement is

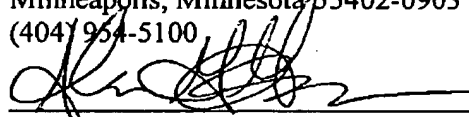
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identified herein, Applicants decline to automatically subscribe to and statement or characterization in the Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 13-2725. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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